

## **REMARKS**

Claims 1 through 22 are pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejection in view of the remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 11 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sibler (U.S. Pat. No. 4,050,281). This rejection is respectfully traversed.

The Examiner has rejected Claims 11 and 18 under 35 U.S.C. § 102(b) as being anticipated by Sibler. The Examiner has referenced Claim 1, lines 21 through 36 of Sibler and has stated that "Sibler does not explicitly teach aligning the moving crosshead horizontally and vertically to an axis as defined by the main ram, however this would be inherent to the invention of Sibler."

Applicant notes that Claim 1, lines 21 through 36 of the Sibler provides:

...connected with the extrusion crosshead, a hollow stem mounted on the extrusion crosshead and extending forward therefrom in axial alignment with said container passage for insertion therein, the extrusion crosshead having an opening through it behind the stem, a mandrel holder carried by the piercer crosshead and extending forward through said opening, a mandrel in said stem supported by said mandrel holder and having a tip at its front end of smaller diameter than the mandrel body behind it, means for supplying hydraulic fluid to the rear ends of the piercer cylinders while fluid is locked in the coupling cylinders to move said stem forward to the billet container, means for then exhausting fluid from the coupling cylinders to permit the forwardly moving piercer crosshead to move the mandrel forward from the stem into said container, stops behind...

(emphasis added). Applicant notes that the only relevant part of Claim 1, lines 21 through 36 of the Sibler reference is that which is underlined - "a hollow stem ... in axial alignment with said container passage for insertion therein". Applicant notes that the Sibler reference does not teach or suggest any method by which the stem is aligned to the container.

In contrast Claim 11 of the present application recites that the container is aligned directly to an axis of the stem. One way in which this may be accomplished is illustrated in

Figure 8 of the present application. As noted in paragraph [0011] of the present application, prior methodologies for aligning components of an extrusion press align the individual components of the extrusion press to a predetermined point or axis, such as the longitudinal axis of the extrusion press. In contrast, the methodology of Claim 11 directly aligns the container to the stem without reliance upon a tertiary axis. Consequently, the methodology of Claim 11 is relatively quicker and tends to provide better alignment accuracy.

As the Sibling reference notes that the stem is axially aligned to the container but does not teach or suggest how this may be accomplished, Applicant submits that the Examiner has not presented a prima facie case of anticipation and that the Examiner has improperly attempted to invoke the theory of inherency. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "*arranged as in the claim*". *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

Under the principles of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated. *In re King*, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986). The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In this regard, the CCPA has added that "[i]nherency, however, may not be established by

probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgird v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original).

Applicant respectfully submits that the Sibling reference does not teach or suggest any method by which the stem and the container are aligned to one another. As such, any remarks concerning how the stem and the container are aligned to one another in the Sibling reference can only be “probabilities or possibilities” that are not sufficient to prove inherency.

Accordingly, Applicant submits that the Examiner has not presented a prima facie case of anticipation and that the theory of inherency cannot be relied upon to “fill the gaps” in the Sibling reference since the Examiner cannot show that Applicant’s method is necessarily employed to achieve alignment of the stem and the container. Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of Claim 11 under 35 U.S.C. 102(b).

Applicant notes, too, that Claim 18 is dependent upon Claim 11. Consequently, Applicant submits that Claim 18 should be in condition for allowance for the reasons set forth above for Claim 11.

#### **ALLOWABLE SUBJECT MATTER**

Claims 1 through 10 have been allowed. The Examiner states that Claims 12 through 17 and 19 through 22 would be allowable if rewritten in independent form.

Applicant has not elected to rewrite Claims 12 through 17 and 19 through 22 in an independent form at this time, but elected instead to pursue the allowance of Claim 11, the base claim from which Claims 12 through 17 and 19 through 22 depend. In view of the above

remarks, Applicant respectfully submits that Claim 11 is in condition for allowance and as such, Claims 12 through 17 and 19 through 22 are in condition for allowance as well.

#### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: November 23, 2004

By: 

Michael D. Zalobsky  
Reg. No. 45,512

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600